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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/284,563

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Blasius Wilhelm

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2481

26574

7590

03/22/2005

SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
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EXAMINER

LEE, SUSAN SHUK YIN

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,563

Applicant(s)

WILHELM ET AL.

Examiner

Susan S. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/24/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 18 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 2-15, 17, 18, 24-30 and 33-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 8 is objected to because of the following informalities:

As to claim 8, line 2 (both occurrences), "the cleaning unit" lacks antecedent basis.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 31, and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 19 and 27 of U.S. Patent No. 6,229,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US Patent No. 6,229,975 read on the instant invention.

Claims 1, 19 and 27 of US Patent No. 6,229,975 discloses an apparatus for electrophotographic producing image patterns on a recording medium comprising at least one printing unit, a toner reservoir for supplying toner to the printing unit (claim 1 of US Patent No. 6,229,975); an elimination means for transfer of the used toner collected from a cleaning station to a used toner container (claim 19 of the US Patent No. 6,229,975) wherein the elimination means can be interrupted in order to enable a replacement of the used toner container free of interruptions of the operation of the printing unit; and a controllable coupling that can be actuated for replacing the used toner container free of printing interruptions is connected between a drive and a conveyor shaft for toner removal from the cleaning station (claim 27 of US Patent No. 6,229,975). These claimed elements read on the instant invention's claims 1, 31, and 32.

Allowable Subject Matter

Claims 2-15, 17, 18, 24-30, and 33-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive. Applicant argues that the non-statutory double patenting rejection of claims 1, 31, and 32 based on judicially created doctrine is in error and a terminal disclaimer was not filed. Examiner disagrees with this because this application is a later

filed application to US Patent Number 6,229,975; applicant could have filed the claims in a single application; and there was no administrative delay in prosecuting the earlier filed application on the part of the Office. Thus, in this case a one-way test for obviousness-type double patenting is only needed. The invention defined in the instant invention is an obvious variation of the invention defined in the claims in the patent. See MPEP 804, B, 1, (a). and *In re Berg*, 46 USPQ2d 1226 (FED. Cir. 1998). The application claims 1, 31, and 32 encompass the '975 patent claims 1, 19, and 27; and the '975 claims anticipate the application claims. A double patenting rejection of the obviousness-type is "analogous to the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). The claimed subject matter (claims 1, 31, and 32) is not patentably distinct from the subject matter claimed in the commonly owned patent to '975. The claimed subject matter of the instant application is broader than the claimed subject matter in the patent to '975. Thus, applicant must file a terminal disclaimer in order to overcome the nonstatutory double patenting rejection. Second, applicant argues that claim 27 of patent to '975 is a full combination and claim 1 of the instant invention is a sub-combination; and that claim 1 of the present application is independent and distinct from the full combination of claim 27 of the copending patent. If these claims were presented together in one application, applicant is assuming that a restriction would be proper. However, a restriction would not have been possible because the subcombination (claim 1 of the instant invention), the means having a controllable coupling, has the same level of

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details as the controllable coupling in claim 27 of the patent to '975. Thus, the subcombination is not independent and distinct from the full combination of claim 27 of the patent to '975. See MPEP sect. 802 and 803.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan S. Lee whose telephone number is 571-272-2137. The examiner can normally be reached on Mon. - Fri., 10:30-8:00, Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Art Grimley can be reached on 571-272-2136 or 571-272-2800 (Ext. 52).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan S. Lee
Primary Examiner
Art Unit 2852

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